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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,059	12/09/2003	Tadanobu Shibabuki	Q78807	2969
23373	7590	02/10/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EVANISKO, LESLIE J	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/730,059	SHIBABUKI ET AL.	
	Examiner	Art Unit	
	Leslie J. Evanisko	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12-09-03 & 06-22-0</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species IV (Figure 8), claims 8-15, in the reply filed on November 19, 2004 is acknowledged.
2. Claims 1-7 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 19, 2004.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the surface of the suction adherence surface including minute protrusions and indentations as recited in claim 13 and the skirt portion comprising a sponge or brush as recited in claim 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not

be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The exact scope of claims 8-15 is somewhat confusing and unclear with respect to whether applicant is intending for the printing plate and protective sheet to be a part of the claimed combination. In claim 8 in particular, it is noted that the preamble appears to be drawn to a sucker per se, but the claim

language in claim 8 as well as other dependent claims also provides some connection with the printing plate and protective sheet. For example, claims 10 and 11 further recite a gap between the protective sheet and suction-adherence surface. Therefore, it is not clear whether the claims are intended to be directed to the sucker structure per se or the combination of the sucker with the printing plate and protective sheet.

In an effort to advance prosecution of the application, the Examiner has interpreted the claims as being drawn to the sucker device per se and not the combination. In response to this Office Action, applicant is required to state on the record what his/her intentions are with respect to the scope of claims 8-15 and to amend the claims as necessary to more accurately reflect those intentions. For example, if the claims are intended to be drawn to the sucker structure per se, then it is suggested that the claim language be amended to recite various features more in terms of the structure of the sucker. For example, in claims 10 and 11, it is suggested to use language such as “....the sucker *being configured* such that when the sucker is suction-adhering the printing plate and protective sheet during the suction-adherence operation, a gap(t) is formed between the suction-adherence surface and the protective sheet, the gap(t) being set....” or similar language.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 8, 12-13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Seto (US 5,156,387). Seto teaches a sucker 100 comprising a main body portion 102 integrally including a mounting base portion and including a suction adherence surface 102a, 108, and a skirt portion 104 attached to the suction adherence surface side of the main body portion 102 and capable of closely corresponding with the sheet member 14, wherein the main body portion has a predetermined stiffness for reducing deformation as recited. Note Figures 3-4 and column 3, line 67 through column 4, line 30, in particular.

Again, note the claims have been interpreted by the Examiner as being drawn to the sucker device per se and not the combination of the sucker and objects which it is gripping (i.e., the printing plate and protective sheet). Therefore, the number of objects the sucker is able to grip is merely a functional intended use and does not effect the structure of the gripper as recited. Since the sucker of Seto includes all of the structure as recited and is

considered to be capable of suction adhering a porous sheet and printing form, it meets the claim language as recited.

With respect to claim 12, note Seto teaches the skirt portion is comprised of rubber material in column 4, lines 27-29 and rubber material would inherently would have a predetermined resilience. Additionally note that Figure 4 shows the surface of the skirt portion 104 that closely corresponds with the object being gripped is substantially parallel to the suction-adherence surface 102b, 108 of the main body 102.

With respect to claim 13, note Seto teaches the suction-adherence surface is comprised of materials such as plastic or metal. It is noted that any material can be considered to have a surface roughness including minute projections and indentations to some extent. Therefore, the plastic or metal main body portion would inherently include minute protrusions and indentations formed in the surface during the manufacture of the main body portion.

With respect to claim 15, note Seto teaches the skirt portion 104 includes an outer periphery capable of closely corresponding with the sheet 14 being gripped during the suction-adherence operation.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seto. Note Seto teaches a gap formed between the suction-adherence surface and the sheet as shown in Figure 4. Clearly the gap formed between the two surfaces will inherently be dependent upon variables such as the resilient force of the skirt, a coefficient of friction between the skirt and sheet, and stiffness of the sheet. It is additionally noted that Seto is silent with respect to whether the gap is specifically set to any desired range as recited. However, it would have been obvious to one of ordinary skill in the art to provide the sucker device of Seto to be configured such that the gap formed

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between the suction-adherence surface and the sheet being gripped does not allow the sheet to be substantially drawn in toward the suction-adherence surface to better minimize the area of the film that contacts the sucker structure and thereby avoid excessive damage to the sensitive surface of the film sheet.

With respect to claim 11, note again that although Seto is silent with respect to the gap size, the optimum size of the gap could easily be determined through obvious routine experimentation to provide a suction gripping mechanism that does not excessive damage the film sheet while providing secure gripping and removal of the sheet from a stack of sheets.

Allowable Subject Matter

11. Claims 9 and 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

With respect to claim 9, the prior art of record fails to teach or fairly suggest a sucker including all of the structure as recited, in combination with and particularly including, specifically meeting the set forth relationship

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between the resilient forces of the skirt portion and the total components of the suction force.

With respect to claim 14, the prior art of record fails to teach or fairly suggest a sucker including all of the structure as recited, in combination with and particularly including, the skirt portion comprising at least one of a sponge and a brush.

Conclusion


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sjodin (US 3,515,424), Marschke et al. (US 3,724,687), McNair (US 4,564,188), Lytle (US 2,815,240), Watter (US 2,725,255), and Stoothoff (US 2,850,279) each teach a sucker device having obvious similarities to the claimed subject matter.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
February 5, 2005